

### **Remarks**

Claims 1 and 3-15 remain pending.

It is noted that Claim 15 was added in the December 4, 2008 Response (the response filed before this final office action). However, Claim 15 was not addressed in this final office action.

The Applicants thank the Examiner for discussing this case with the Applicants' representative on June 29, 2009. Claims 1, 3, 4-7, 9, 11 and 13-15 are amended based on the Examiner's helpful suggestions during that discussion. (Claims 1 and 6 are amended also to remove minor informalities.) It is respectfully submitted that the amendments do not add new substantive matter to the claims, but simply put the application in better condition for allowance or appeal and, therefore, should be entered.

### **Section 112, First Paragraph Rejections**

Claims 1 and 3-14 are rejected under Section 112, first paragraph. Allegedly, the phrases "merchant account" and "no funds are stored;" recited in Claim 1, "merchant account" and "lock box account does not store funds;" recited in Claim 5 and "merchant account;" recited in Claim 4, are not supported by the originally-filed application. Based on the following, the Applicants respectfully request reconsideration and withdrawal of the Section 112, first paragraph rejections.

With regard to "merchant account," it is noted that the word "account" was added to the claims for the first time in the December 4, 2008 Response to the June 12, 2008 Office Action. "Account" was added because the Applicants' representative understood this amendment to be required to put the December 4, 2008 claims in condition for allowance as per a December 1, 2008 conversation with the Examiner. This understanding is documented in the December 4, 2008 Response. (See December 4, 2008 Response, page 9.) This was discussed during the June 29, 2009 conversation whereupon the Examiner agreed to enter an after-final amendment that returned the claim language as before the December 4, 2008 Response (the Response filed before this final Office Action); namely to remove the word "account" from "merchant account." Because "merchant" is clearly supported by the originally-filed application, the Examiner also agreed to then remove the Section 112, first paragraph rejection with regard to this phrase.

Claims 1 and 3-7 are amended to recite "merchant" instead of "merchant account." (Claim 4 was further amended for clarity in light of the removal of the word "account.") Support for merchant is found in the originally-filed claims and, for example, at page 3, lines 3, 4, 9, 12, 15; page 4, line 8, etc. of the originally-filed specification.

With regard to “lock box account does not store funds,” it is noted that in the February 14, 2008 Response (the Response filed before the June 12, 2008 non-final Office Action issued) the claims were amended to recite the lock box account and that this account does not store funds. (See e.g., February 14, 2008 Response, Claim 1 on page 2.) In addition, the Response identified where these elements are supported by the originally-filed application.

The subsequent non-final Office Action that issued on June 12, 2008 did not find the phrase “lock box account does not store funds” unsupported by the originally-filed application and did not reject any claims based on Section 112, first paragraph. This was discussed on June 29, 2009 and the Examiner agreed to remove the Section 112, first paragraph rejection with regard to the phrase, the “lock box account does not store funds.”

#### **Section 112, Second Paragraph Rejections**

Claims 1, 3 and 6-12 are rejected under Section 112, second paragraph. Allegedly, it is unclear to which account the “account number;” recited in Claims 1 and 6, refers. Based on the following, the Applicants respectfully request reconsideration and withdrawal of the Section 112, second paragraph rejections.

First, Claims 3, 7, 8 and 10-12 did not recite “the account;” however, they were rejected under Section 112, second paragraph. Therefore, it is respectfully submitted that the rejection should be withdrawn with respect to these claims.

Second, in the February 14, 2008 Response (the Response filed before the June 12, 2008 non-final Office Action issued), Claims 2 and 6 were amended to recite “account number.” In the December 4, 2008 Response, the subject matter of Claim 2 was incorporated into Claim 1. Nevertheless, the June 12, 2008 non-final Office Action did not reject Claims 2 and 6 under Section 112, second paragraph based on reciting “account number.” This Section 112, second paragraph rejection was issued for the first time in this March 5, 2009 final Office Action.

During the June 29, 2009 discussion, the Examiner stated that he would accept and enter, after final, an amendment to the claims clarifying the “account number” and subsequently remove the Section 112, second paragraph rejections. In this regard, Claim 1 is amended to recite “establishing, over a computer network, a purchasing limit and ~~an~~ a **lockbox** account number and storing, over a computer network, the purchasing limit and the **lockbox** account number within the lock box account.” Claim 6 is amended to recite “means for entering the **lockbox** account number;” “means for electronically routing the **lockbox** account number and access code to the service provider computer . . .” and “means for confirming the **lockbox**

account number and access code . . .” Claims 9 and 13-15 are also amended to recite “lockbox account” in place of “the account.” It is respectfully submitted that the account number recited in the claims is now clear.

### **35 USC § 101 Rejections**

Claims 1, 3 and 8-12 are rejected under Section 101 in light of the Federal Circuit’s November 2008 decision in *In re Bilski*.

During the June 29, 2009 discussion, the Examiner stated that he would enter an amendment to these claims, after final, that is made in an effort to overcome the Section 101 rejection. The Applicants thank the Examiner for this opportunity. As provided below, Claims 1, 3 and 11 are amended to overcome the Section 101 rejection. For the following reasons, the Applicants respectfully request reconsideration and withdrawal of the Section 101 rejection.

*Bilski* held that “the machine-or-transformation test . . . is the governing test for determining patent eligibility of a process under § 101.” See *Ex parte Srinivas Gutta* (Appeal 2008-3000) citing *In re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008). The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. *Id.* pages 3 and 4, citing *Bilski* at 961-62.

Claims 1, 3 and 11 have been amended to tie the steps of the method to a particular machine. For example, the step of “verifying electronically and over a computer network, that the consumer has an established credit card account” has been amended to read, “***a system provider computer*** verifying electronically and over a computer network, that the consumer has an established credit card account.” The system provider computer is a “particular machine.” In this regard, it is noted that Claim 1 is amended to read similarly as Claims 4 and 5, which recite particular machines and, accordingly, were not rejected based on Section 101.

It is respectfully submitted that, for the foregoing reasons, Claim 1 is allowable over Section 101 as applied by *Bilski*. Claims 3 and 8-12 depend from Claim 1 and, therefore, are also allowable.

### **Finality of Section 103 Rejections**

Claims 1, 4-6 and 8-14 stand rejected as unpatentable over Cheong in view of Hutchinson, Cohen and now Mullins.

Mullins is a “new” reference applied to the claims for the first time in this final Office Action. Mullins was applied in response to the amendments to Claim 1, made in the December

4, 2008 Response. In particular, the Office Action finds that Mullins discloses the elements of Claim 2. (See Office Action, page 8.)

As provided above, in the December 4, 2008 Response, Claim 1 was amended to incorporate only the subject matter of existing Claim 2. In other words, incorporating the elements of existing Claim 2 were the only substantive amendments made to Claim 1. Nevertheless, another search was conducted and a Section 103 rejection is now made final. It is respectfully submitted that the elements of the dependent claims; including previously-dependent Claim 2, should have been fully searched by now. (See e.g., MPEP 707.07(g).) Even assuming *arguendo* that there was some reason to not have fully searched the dependent claims, it is respectfully submitted that it was improper to make this Section 103 rejection final. At the least, the Applicants should have had a fair opportunity to address the Mullins reference.

#### **Substance of Section 103 Rejections**

As stated above, Claims 1, 4-6 and 8-14 stand rejected based as unpatentable over Cheong in view of Hutchinson, Cohen and now Mullins. Based on the following, the Applicants respectfully request reconsideration and withdrawal of the Section 103 rejections.

First, the Applicants note that the claims are rejected based on the combination of four references. It is noted that “[t]he requisite prior art suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references . . .” See 5-313 Donald S. Chisum, *Chisum on Patents*, 5.04[1][e][vi] (2007)

Second, it is respectfully submitted that the Office Action has not met its burden of showing that each and every element of the claims is met by the cited references and, therefore, has not made a *prima facie* case of obviousness.

Cheong is the “primary” reference in the Section 103 rejections. However, Cheong has not been applied to the current claim language. For example, the Office Action finds that Cheong discloses “creating an electronic data account.” (See Office Action, page 5.) “Creating an electronic data account” is no longer the language in Claim 1. Similarly, the Office Action finds that Cheong discloses “authorizing an amount of credit within the financial account of limited access.” A financial account of limited access is no longer recited in Claim 1. This element was deleted in the August 15, 2007 Response. (It appears that this is the result of the same language simply being copied from Office Action to Office Action.)

In addition, Claim 1 recites, “wherein the consumer credit card account is stored in the lock box account.” The Office Action does not identify which reference, if any, discloses this element.

Claim 1 also recites, “requesting funds from the consumer’s established credit card account corresponding to the amount of the purchase transaction; and routing funds corresponding to the amount of the purchase transaction directly from the consumer’s credit card account to the merchant.” The Office Action finds that Cheong discloses “requesting funds from the customer’s established credit card account and routing the funds to the merchant;” however, the Office Action does not cite to the portion that allegedly discloses this element. (See Office Action, page 5.) Column 15, lines 15-18 of Cheong; cited by the Office Action as disclosing “creating a data account number and access code and confirming the credit amount and access code” does not disclose “requesting funds from the customer’s established credit card account and routing the funds to the merchant.” In fact, that portion of Cheong does not even disclose “creating a data account number and access code and confirming the credit amount and access code.” Rather, it discloses withdrawing *pre-loaded* funds from the surrogate card rather than debiting that card against purchases. In other words, funds are routed from the surrogate account; not from a consumer’s credit card account.

In addition, the Office Action states,

... credit card transaction is old and well-known (sic), where the merchant forwards the customer receipt to merchant account bank with total collection amount and during the process the customer’s available credit limit is reduced to new value. For example, a customer with outstanding purchasing limit of \$10,234.23 (max limit – total spending up to this point) charges another \$1000.00, the new limit is reduced to \$9234.23 (see any consumer’s credit card statement), the merchant bank collect the money from credit card company less the credit card fee and forwards to merchant (deposit to merchant account) the collected amount less banks processing fees/commission.

Similarly smart cards are known which have memories for holding the spending limits, upper limit, password, controlling the spending limits and authorization for higher limits, and transaction history and can be used where the merchant does not need to get authorization like regular cards.

(See Office Action, pages 6-7.) The Office Action does not apply the elements of a credit card transaction against the claim elements; in other words, which element of Claim 1 the above discloses or which deficiencies of Cheong the above satisfies. In addition, the Office Action does not provide any motivation for modifying Cheong's structure to include the above.

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Similarly smart cards are known which have memories for holding the spending limits, upper limit, password, controlling the spending limits and authorization for higher limits, and transaction history and can be used where the merchant does not need to get authorization like regular cards.

(See Office Action, page 7.) Again, the Office Action does not apply the elements of a smart card transaction against the claim elements; in other words, which element of Claim 1 the above discloses or which deficiencies of Cheong the above satisfies. In addition, the Office Action does not provide any motivation for modifying Cheong's structure to include the above.

For the foregoing reasons, it is respectfully submitted that the Office Action has not met its burden with respect to the Section 103 rejection.

In addition, for the following reasons, it would not have been obvious to one skilled in the art to combine the cited references. Further, even assuming that it would have been obvious to combine the references, the combination does not meet every element of the claims.

The Office Action admits that Cheong does not disclose a lock box or an equivalent and that the lock box does not store funds. It finds that Cohen discloses "electronic safety deposit boxes," which are allegedly the recited lock box and, it would have been obvious to modify Cheong's system based on Cohen's disclosure.

First, Cohen does not disclose the non-funded lockbox. Cohen discloses an e-commerce system comprised of a "metabank" and a "webbank." These are essentially on-line banks. (See e.g., [0031], "[t]he webbank™ (also referred to as a milliibank™ minibank, or so forth) is a new financial vehicle consisting of a miniature Internet bank, i.e. a personal or corporate Internet bank which anyone can open on the World Wide Web. By accessing the metabank over the Internet, anyone can "own their own bank", i.e. quickly create and open a private bank in cyberspace.") In other words, these "banks" store a user's funds like a traditional bank, but are without the infrastructure. Put another way, in contrast with what is recited in the claims, these banks *are funded accounts* in that money is "permanently" stored in the account.

Further, the “Electronic Safety Deposit Box” component is not the recited electronic account into which data is stored relating to the consumer and no funds are stored. The Electronic Safety Deposit Box is like a physical safety deposit box at your local (physical) bank but is electronic rather than physical. In that regard, it stores and secures items such as important documents. Cohen provides, “[a]ccordingly, the user can easily and quickly access and present verified, digital copies of important documents and records from a central location, for self-access or presentation to third parties.” (Cohen, Paragraph [0068]; *see also*, [0018], “Webbanks can also be set for **record keeping** and presentation purposes, e.g. as electronic safety deposit boxes maintained by a trusted neutral party (i.e. the metabank), for ***maintaining secure copies of important records***, and for presentation of authenticated materials to third parties” (emphasis added).) The Electronic Safety Deposit Box does not route funds to a merchant. (Cohen recites that the Webbanks can also be set as “transactional gatekeepers,” however, this is not enabled and it is not the recited lockbox.) Thus, Cohen does not disclose the recited lockbox.

Second, even assuming *arguendo* that Cohen discloses a lockbox, it would not have been obvious to one skilled in the art to modify Cheong’s system to include the recited lockbox in place of Cheong’s funded surrogate system.

Cheong discloses a “surrogate system” for electronic commerce transactions that allows an individual *without a credit card* to shop at online merchant sites. The surrogate system ***account is funded*** using numerous fund sources. A user with a funded account can shop at numerous merchant web sites ***through the surrogate system***. (In other words, the user cannot access a merchant site directly but must go through the surrogate site.) When merchandise is selected for purchase, a purchase transaction is executed in which a “surrogate system credit card” is temporarily or permanently assigned to the user. The surrogate system credit card, once loaded with funds from the user’s corresponding funded account, is used to complete the purchase transaction. The surrogate system provides controls that include monitoring the data streams and, in response, controlling the information flow between the user and the merchant sites. (See Cheong, Abstract, emphasis added.)

Although it is not clearly articulated, it is assumed that the Office Actions have found that it would have been obvious to one skilled in the art to substitute Cohen’s Electronic Safety Deposit Box for the surrogate system of Cheong’s system.

Cheong's disclosure makes it clear that one skilled in the art would not look to Cohen to modify Cheong's system. Cheong teaches away from non-funded accounts, such as accounts that rely on a credit card, as that recited in the independent claims of the present application. Cheong states,

Numerous non-cash techniques are typically used for executing purchase transactions among purchasers and online merchants. Indeed, numerous types of *credit cards* and banking cards are in widespread use. For example, a credit card can be used to effect online purchases, *with the transaction being paid for by a credit card clearing house or bank and creating a credit obligation for the owner of the credit card*. . . . Payment is effected from a bank to the merchant and the funds are deducted directly from the card holder's bank account.

However, *the problem with credit cards* . . . is that certain conditions have to be met for issuance . . .

One possible solution to this problem for some, particularly minor children, is found in *secondary credit cards*. A credit card holder may obtain one or more secondary credit cards from the issuer, as for example for family members, that are linked to the main credit card. The secondary credit cards are functionally identical to the main credit card in all respects and, indeed, typically bear the same account number and differ from the primary card only in the name of the person who is authorized to use the secondary card. Any purchases made with the secondary credit cards are debited against the credit limit of the single account in which the primary and secondary cards are issued. Thus, the main or primary cardholder has no control over the spending power or abilities of the secondary credit cards linked to his card, beyond the fact that the total of all debts incurred by all cards on the account cannot exceed the credit limit of the main credit card.

*These secondary credit cards, therefore, are problematic* because the secondary cardholders can quickly accumulate a significant outstanding balance on the main credit card account, thus reducing the main cardholder's spending power . . .

(See Cheong col. 1, lns. 16-55; col. 2, lns. 14-25, emphasis added.) Thus, Cheong clearly teaches away from any non-funded accounts or accounts that simply route funds from one source (i.e., credit card bank) to another (merchant).

As such, every embodiment of Cheong's system requires a *previously-funded* payment means; the "surrogate." The surrogate has money loaded thereon before purchases can be made. It is a funded account. (See e.g., Abstract, "[t]he [surrogate] credit card, *once loaded with funds*



from the user's corresponding funded account, is used to complete the purchase transaction;" col. 8, lns. 46-50, "once created, an account is funded *prior to* executing purchase transactions or *concurrently with* a purchase transaction.") Thus, one skilled in the art would not be motivated to combine Cheong's and Cohen's systems nor would he or she be motivated to modify Cheong's structure to include an electronic safety deposit box that does not store funds, in place of the funded surrogate payment system or to include the recited non-funded lock box or request funds from the consumer's established credit card account, route funds corresponding to the amount of the purchase transaction directly from the consumer's established credit card account to the merchant account, as recited in Claim 1, for example. To do so would render Cheong's system inoperable for its intended purpose. (Similar arguments were made in the August 13, 2007 Response to the July 6, 2007 Office Action.)

Independent Claims 4 and 5 are allowable for the reasons Claim 1 is allowable.

Claim 4 recites, "the system provider computer in communication with the credit card bank computer for verifying consumer credit card account information and for *requesting and receiving funds* for issuing payments to a merchant account *after a consumer executes a purchase transaction*," "the system provider computer in communication with the merchant computer and merchant account for verifying consumer lock box account information and *for issuing funds received from the credit card bank computer to pay for consumer purchase transactions*" and "wherein the lock box does not store funds."

Claim 5 recites, "means for requesting funds from the consumer's established credit card account *after the consumer executes a purchase transaction*," and "wherein the lock box account does not store funds."

Further, even assuming *arguendo* that one skilled in the art would be motivated to combine the references, the combination would not meet every element of the independent claims. In particular, the Office Action finds that Cheong discloses "requesting funds from the customer's established credit card account and routing the funds to the merchant." In support, the Office Action cites col. 15, lns. 15-18 of Cheong. This portion of Cheong does not disclose the claim elements. This portion discusses withdrawing *pre-loaded* funds from the surrogate card rather than debiting that card against purchases. That paragraph begins, "[i]n an alternate embodiment, a user can withdraw cash from their surrogate system account using an ATM, Internet-connected kiosks, and point-of-sale devices . . ." The portion cited by the Office Action states, "the cash withdrawal can be made in response to information received from a credit or

debit card assigned to the user on their account by the surrogate system.” (It is likely that a search for the word “credit card” was performed and this portion was inserted without reading the actual portion cited.)

The only use of a credit card disclosed in Cheong’s system refers to *loading funds to the surrogate* using a credit card. In other words, the credit card provides the pre-loaded funds for the account. (See also Abstract, “the account can be funded using numerous fund sources, for example credit cards, checking accounts, money orders, gift certificates, incentive codes, online currency, coupons, and stored value cards.”) It is not used to execute the purchase transaction as recited in the claim. Presumably, a user would “buy,” for example, \$100.00 with their credit card, which would fund the surrogate with \$100.00. The user would have a \$100.00 charge on their credit card *to the surrogate system*. That \$100.00, once loaded, would then be used to make internet purchases. This is in contrast to the presently-claimed system where the user’s credit card is charged *by the merchant* through the lock box.

It is respectfully submitted that, for the foregoing reasons, one skilled in the art would not be motivated to combine Cheong and Cohen’s systems. Even assuming *arguendo* that they would be motivated to do so, the combination would not meet every element of the claims.

As provided above, the Office Action applies Mullins for the first time, in combination with Cheong, Hutchinson and Cohen. The Office Action provides that “[i]t would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Cheong, Hutchison and Cohen and include the above features as disclosed by Mullin (sic) to provide a pseudo monetary system with database (sic) which associates the pseudo account number to actual financial account (sic) and allow (sic) the customer to use pseudo account number instead of his/her credit card for online purchases and prevent fraud (sic).”

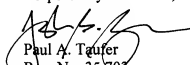
It is respectfully submitted that one skilled in the art would not be motivated to combine Mullins and Cheong’s system. In particular, one skilled in the art would not be motivated to associate an account number with the surrogate card of Cheong. Figure 37 of Cheong shows a purchase screen using its system. A user logs onto a website, through the surrogate system website through which the user has logged on. After selecting products, at checkout, “Rocketcash” is *automatically* filled into the payment windows so that the *user does not see any information* regarding the payment vehicle. (See col. 20, lns. 4-10.) Thus, there is no motivation to amend Cheong’s system using Mullins’s account number.

Even assuming *arguendo* that one skilled in the art would combine Mullins and Cheong's systems, the combination would not meet every element of the claims. The Office Action finds that the database of Mullins is the lockbox and, therefore, Mullins discloses "routing the dollar amount of the purchase transaction and the entered lock box account number to the lockbox (here - account in database) . . ." (See Office Action, page 8.) Mullins's database is not a lockbox. In particular, Mullins's database is funded as is the surrogate account in Cheong's system and the electronic bank account in Cohen's system. Mullins states, "waterproof wristband is exchanged for a specified prepayment of money made by cash, or by authorization to pay made by credit card or other acceptable means." (Mullins, col. 2, lns. 28-33.) This prepaid, funded account, is debited against subsequent transactions. (Mullins, col. 2, lns. 22-36.) For these reasons, Mullins does not disclose the recited lockbox or "routing the dollar amount of the purchase transaction and the entered lock box account number to the lockbox."

For the foregoing reasons, independent Claims 1, 4 and 5 are allowable. Claims 3, and 8-12 depend from Claim 1 and, therefore, are allowable. Claims 13-15 depend from Claim 4 and, therefore, are allowable. Claims 6 and 7 depend from Claim 5 and, therefore, are allowable.

In view of the foregoing, Applicants respectfully submit that the entire application is now in condition for allowance, which notice is respectfully requested.

Respectfully submitted,



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